

Application No : 10/518,436
Amdt dated: April 18, 2007
Reply to Office action of January 22, 2007

REMARKS/ARGUMENTS

This Amendment is filed in response to the Office action that was mailed on January 22, 2007. Claims 1-9 and 15-23 are pending in this Application. By this Amendment, Claims 1, 2, 7, 15, 16 and 21 are amended and Claims 28-33 are new. The amendments do not introduce new matter as they are fully supported by the Claims, Specification and Drawings as originally filed or are inherent characteristics thereof. Additionally, new Claims 28-33 do not introduce new matter as they are fully supported by the Claims, Specification and Drawings as originally filed or are inherent characteristics thereof. Applicants respectfully request reconsideration and allowance of all Claims in view of the following remarks.

Claims 1, 2, 4-9, 15, 16 and 18-23 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,904,693 to Dicesare et al. (Dicesare '693). To be anticipating, a prior art reference must disclose each and every limitation of the claimed invention, the prior art must be enabling, and the prior art reference must describe the claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339 (Fed. Cir. 2000).

The Examiner indicated that Dicesare '693 discloses a laparoscopic clip applicator having a disposable cartridge including an elongate tube (col. 2, lines 55-56), a pair of opposing jaw members extending outwardly from the distal end of the elongate tube (Figures 3 and 15), a one-way ratchet mechanism (col. 2, lines 42-45), and a

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reusable actuating mechanism (col. 2, lines 8-9). The Examiner further indicated that the actuating mechanism comprises a main body and an actuating handle (Figures 1, 3, 15 and 20) and that the disposable cartridge further comprises a push member (col. 4, lines 12-15) for advancing the clips into the jaw members; a biasing or retaining spring (col. 2, lines 30-35); and a drive coupling connected to a sliding ratchet pawl for engaging with mating teeth formed on an inner surface of the elongate tube (Figures 18 and 19), also having a central connection. Additionally, the Examiner indicated that the actuating mechanism can be said to further comprise a plurality of tips and an actuating handle, and that the cartridge further comprises a jaw loader for advancing the clip into the jaw members and a drive bushing (col. 2, line 60 – col. 3, line 13). Applicants respectfully traverse this rejection.

Amended Claims 1 and 15 are drawn to a clip applier having a disposable cartridge that includes a one-way ratchet mechanism having fixed mating teeth. In the Office action, the Examiner indicates that Dicesare '693 includes a one-way ratchet mechanism and refers to column 2, lines 42-45 of Dicesare '693 to support that statement. However, column 2, lines 42-45 of Dicesare '693 teaches a ratchet mechanism within the handle of the clip applier, as opposed to a one-way ratchet mechanism positioned in the disposable cartridge as is claimed in Applicants' Claims 1 and 15. In the Office action, the Examiner also indicates that the disposable cartridge of Dicesare '693 includes a sliding ratchet pawl for engaging with mating teeth formed on an inner surface of the elongate tube and refers to Figures 18 and 19 to support that

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statement. However, Figures 18 and 19 of Dicesare `693 teach a two-way ratchet mechanism (see Dicesare `693, Figures 18 and 19 and column 14, line 58 through column 15, line 26), as opposed to the one-way ratchet mechanism claimed in Applicants' Claims 1 and 15.

In the Office action, under the heading "Response to Arguments," the Examiner indicates that column 8, lines 9-27, of Dicesare `693 also describe what can be considered a ratchet mechanism found in the disposable cartridge. As taught by Dicesare `693 at column 8, lines 9-27, the so-called "ratchet mechanism" includes a plurality of flexible, bent leaf springs (50), with each leaf spring being positioned to engage one ligation clip. As the clips are advanced forward, the leaf springs are flexed upwardly and do not inhibit such movement. Applicants respectfully submit that the mechanism taught in Dicesare `693 at column 8, lines 9-27, do not include fixed mating teeth as is claimed in Applicants Claims 1 and 15. Additionally, Dicesare `693 does not teach that the mechanism taught at column 8, lines 9-27 is a ratchet mechanism, but that it merely "acts like a ratchet mechanism...." Further, the mechanism taught in Dicesare `693 at column 8, lines 9-27 is not adapted to provide a full actuating stroke of the clip applier before an engagement in the ratchet mechanism releases and returns to the original position, as is claimed in Applicants Claims 2 and 16. Instead, each of the clips is moved in a forward direction until it is advanced into the feeding position; the clips do not return to their original position.

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New Claims 28-33 include a second ratchet mechanism positioned in the disposable cartridge. Claims 29 and 32 include the second ratchet mechanism being substantially a mirror image of the first ratchet mechanism. Applicants respectfully submit that Dicesare `693 fails to teach a second ratchet mechanism positioned in the disposable cartridge and further fails to teach a second ratchet mechanism that is substantially a mirror image of the first ratchet mechanism.

Based on the foregoing, Applicants respectfully submit that Dicesare `693 fails to teach each and every limitation of Applicants' claimed invention and that, therefore, Claims 1-9 and 15-23 are allowable over Dicesare `693. As new Claims 28-30 depend from allowable Claim 1 and Claims 31-33 depend from allowable Claim 15, Applicants also respectfully submit that they are also allowable over Dicesare `693.

Claims 3 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dicesare `693, as applied to Claims 1 and 15 above. The Examiner indicated that Dicesare `693 does not expressly disclose forming the ratchet mechanism from injection molded plastic, but that it is common to form surgical devices, including ratchet mechanisms, out of plastic because of its light weight.

Claim 3 depends from amended Claim 1 and Claim 17 depends from amended Claim 15. As stated above, Applicants respectfully submit that amended Claims 1 and 17 are allowable over Dicesare `693. Therefore, Applicants respectfully submit that


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Claims 3 and 17 are also allowable over Dicesare '693, as each depends from an allowable claim.

Applicants respectfully request that a timely Notice of Allowance be issued in this case. If the Examiner believes that a telephone conference with Applicants' attorney might expedite prosecution of the Application, the Examiner is invited to call at the telephone number indicated below.

Sincerely

APPLIED MEDICAL RESOURCES

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